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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,524	06/20/2001	Mark M. Lavoie	1571.2019-001	2618

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EXAMINER

MILLER, WILLIAM L

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,524

Applicant(s)

LAVOIE, MARK M.

Examiner

William L. Miller

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-32 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinan et al. (US#5212898).

3. Regarding claims 17 and 22, Dinan discloses a sign comprising: a main body 11,12 having a first surface 11 and a second surface 12; an overlay removably attachable to the first surface in a first position (such as 61) and the second surface in a second position (such as 62); at least two fasteners 70 for removably securing the overlay to the first and second surface.

4. Regarding claims 18 and 22, the fastener passes through a hole in the overlay which is being viewed and labeled as an “oversized hole.”

5. Regarding claims 19 and 22, each fastener is movably secured to the overlay with a washer (middle washer 75) which spaces the overlay from the main body when the overlay is attached thereto.

6. Regarding claim 20, the main body is made of corrugated plastic, i.e. including hollow cells (col. 2, lines 57-64).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 12-14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian et al. (US#5675923) in view of Cordola (US#5173026).

9. Regarding claims 1 and 22, Sarkisian discloses a sign comprising: a main body 12 having a first (front) surface and a second (rear) surface; a removable overlay 14 attachable to the first (front) surface in a first position and the second (rear) surface in a second position via a storage pocket on the second (rear) surface (col. 6, lines 45-47); and at least two fasteners 72 attached to the overlay for removably securing the overlay to the first (front) surface.

10. Sarkisian fails to disclose the fasteners each passing through an oversized hole in the overlay and movably secured thereto via a washer whereby the washer provides spacing between the overlay and the main body upon assembly as claimed by the applicant. However, utilizing a washer as a spacing member is well known in the fastener art as Cordola discloses a fastening member 13 passing through an oversized hole 19 in a first panel 17 and movably secured thereto via a washer 14 whereby the washer provides spacing between the first panel and a second panel 18 upon assembly. The washer inherently preventing damage to adjacent panel surfaces during assembly. Therefore, as taught by Cordola, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the fastening members of Sarkisian such that the fastening members passed through an oversized hole in the overlay and were movably

secured thereto via a washer whereby the washer provided spacing between the overlay and the main body upon assembly. The washer thereby preventing damage to the overlay and main body during assembly.

11. Regarding claims 2 and 3, the main body and overlay can be plastic (col. 3, lines 60-65, and col. 4, lines 18-19) .

12. Regarding claim 4, the main body and overlay include a retroreflective sheeting (col. 3, lines 35-44, and col. 4, lines 35-38).

13. Regarding claims 5-10, Sarkisian fails to disclose the retroreflective sheeting including glass beads, cube corner prisms, a barrier film, or adhesives as claimed by the applicant.

However, as admitted by the applicant on page 5 of the specification, "any suitable sheeting used in signage can be employed". Therefore, it would have been an obvious matter of engineering design choice to modify the sign disclosed by Sarkisian by utilizing retroreflective sheeting including glass beads, cube corner prisms, a barrier film, and adhesives, since the applicant has not disclosed the specific type of retroreflective sheeting solves any stated problem or is for any particular purpose, and it appears the sign would perform equally well with any suitable sheeting.

14. Regarding claim 12, Sarkisian discloses a mounting device 20.

15. Regarding claims 13 and 14, Sarkisian discloses the fasteners as snaps which according to Fig. 7 include a shank. The shank inherently being expandable and/or deformable to function as a snap.

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view of Cordola, and further in view of the admitted prior art (APA).

17. Sarkisian fails to disclose the sign having a slit such that it can be folded as claimed by the applicant. However, the applicant admits on page 7 of the specification it is known to cut a sign in half (slit) and reconnect it with hinges such that the sign can be folded. Therefore, as taught by the APA, it would have been obvious to one of ordinary skill in the art to modify the sign disclosed by Sarkisian by including a slit therein such that the sign can be folded.

18. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkisian in view of Cordola, and further in view of Dinan et al. (US#5212898).

19. Regarding claims 15 and 16, Sarkisian fails to disclose the plastic main body including hollow cells as claimed by the applicant. As discussed previously, Dinan discloses a sign wherein a main body 11,12 is made of corrugated plastic, i.e. including hollow cells, thereby providing increased flexibility of the main body. Therefore, as taught by Dinan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sign of Sarkisian such that the main body included hollow cells thereby increased flexibility of the main body.

Allowable Subject Matter

20. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

21. Claims 23-32 are allowed.

Response to Arguments

22. Regarding Sarkisian, the applicant argues the storage pocket on the second surface of the main body does not removably secure the overlay to the sign as claimed by the applicant. Specifically, the applicant argues: 1) if the sign in Sarkisian is not stored in an upright position, the overlay could fall out of the pocket; and 2) a storage pocket adds weight to the sign making it more difficult to move around. The examiner agrees with above points 1) and 2), however, the claims do not include any limitations regarding the orientation or weight of the sign. The storage pocket disclosed by Sarkisian on the second surface of the main body removably secures the overlay thereto when the overlay is stored in the pocket.

23. Regarding the 35 U.S.C. 103 rejections and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Cordola has been applied as a teaching (modifying) reference disclosing an oversized hole and cooperating spacing washer, and Dinan has been applied as a teaching (modifying) reference disclosing a main body including hollow cells. The base reference of Sarkisian provides the overlay removably attachable to the first and second surface of the main body.

24. The examiner notes the applicant did not present any arguments pertaining to the examiner's analysis of the applicant's own admissions and/or the admitted prior art (APA) relevant to claims 5-11. The applicant has thus effectively conceded to the examiner's analysis thereof.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

William L. Miller
Primary Examiner
Art Unit 3677

WLM
11-06-03